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Trademark Law

November 22, 2002

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

Re: Application Serial No.:   09/414,290
     Confirmation No.:   3095
     Appellants: Jeffery M. Enright, et al.
     Title: Remote Viewing of ATM Transaction Records
     Docket No.:   D-1112R1

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate for filing in the above-referenced application.

It is believed that no extension of time is required. However, if such an extension is required then please consider this a petition therefore.

Please charge the fee required with this filing ($320) and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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D-1112R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Jeffery M. Enright, et al.	)))	
Serial No.: 09/414,290	))	Art Unit 3624
Confirm. No.: 3095	))	Patent Examiner
Filed: October 7, 1999	)))	Jeffrey C. Pwu
Title: Remote Viewing of ATM Transaction Records	))	

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192

Sir:

The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in duplicate,

concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is

Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-43 are pending in the Application.

Claims 1-37 were rejected under 35 U.S.C. § 102(b) as being anticipated by Blackwell, et al. (US 5,602,933) ("Blackwell").

Claims 38-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Blackwell in view of Odle (US 5,491,511).

These rejections were the only rejections present in the Office Action ("Action") dated August 15, 2002, which was made Final. Appellants appeal the rejections of the claims, inclusive.

STATUS OF AMENDMENTS

A final rejection was made August 15, 2002. No amendments to the claims were requested to be admitted after the final rejection.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary form of the invention is directed to a system which permits the storage and retrieval of images and transaction data produced in the operation of an ATM. An ATM record system (10) includes a plurality of cameras (24, 26, 28, 30) positioned adjacent an ATM (12). An image recorder device (40) includes a computer in operative connection with the cameras. The computer is operative to include in a data store (42), digital image data corresponding to signals from the cameras and transaction data corresponding to transactions carried out at the ATM. Image data may be captured in response to the operation of selected transaction function devices (14, 16, 18, 20, 22). For example, the operation of a card reader (14) may be used as a trigger to capture image data so that there is a record of the user that input the card. The computer includes a server connected to a network (44), such as the Internet. The server can have a uniform resource locator (URL) or other system address. The server can be accessed by remote terminals (46, 52) connected to the network. Thus, ATM image data and transaction data may be selectively accessed by remote terminals at later dates. Particularly note Specification pages 20-22 and Figures 1-2.

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CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

1).   Whether Appellants' claims 1-37 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Blackwell.

2).   Whether Appellants' claims 38-43 are unpatentable under 35 U.S.C. § 103(a) over Blackwell in view of Odle.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

Each of Appellants' claims recites at least one element or combination of elements not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include three independent claims (claims 1, 38, and 41). Claims 2-37 depend from claim 1. Claims 39-40 depend from claim 22. Claims 42-43 depend from claim 41. All pending claims 1-43 are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of

obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The Blackwell Reference

Blackwell is directed to a method of remotely verifying a customer's credentials. Of primary importance to Blackwell is the ability to manually verify the identity of a customer at a remote terminal by a banker person at a verification terminal (col. 12, lines 8-11). A verification terminal (30, 32, 34) at a verification location is connected to a remote terminal (20, 22, 24) at a remote location (col. 5, lines 34-42; Figure 1). A remote terminal (Figure 2) is operated by a customer. A verification terminal (Figure 3) is operated by a bank authority person. A verification terminal can be connected with more than one remote terminal (col. 5, lines 65-66). A remote (customer) terminal (Figure 2) includes a document camera (52) to provide an image of

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an identity document, another camera (54) to provide an image of a customer, and a further camera (56) to provide an image of the remote terminal (col. 6, lines 41-58). Camera signals may be viewed on a monitor (72) at the verification terminal.

During a verification operation, the banker (located at a verification terminal distant from the customer terminal) views a customer's identity document placed in view of the document camera (52). After the banker concludes that the identity document is authentic, then the banker clicks their mouse to capture an image of the identity document (col. 13, lines 43-53). The image of the identity document is then digitized and stored in a file (col. 13, lines 53-55; col. 15, lines 31-33). The banker can then sign a digitizer tablet to provide verification of the filed image (col. 13, lines 58-61; col. 15, lines 33-35). The digitized signature is formed into another file (col. 13, lines 61-63). The banker then transmits a command to merge the files together into a single file for permanent storage (col. 14, lines 1-5). The banker can then begin to assist the customer, such as in opening an account or completing loan application papers (col. 14, lines 24-28; col. 15, lines 58-61).

The Odle Reference

Odle is directed to the capture, storage, and retrieval of visual and digitized information in a surveillance system. A stated advantage of the Odle system is the separate storage of both a mixed composite video signal and digital transaction data to make it difficult for anyone to tamper with a transaction record (col. 7, lines 12-25). The stored mixed composite video signal contains a tremendous amount of video information (col. 1, lines 17-21 and 38-42; col. 2, lines

35-39). Use of a pointer makes it easy to identify and view the portion of the mixed composite video signal which corresponds to a particular digital transaction record (col. 2, lines 56-61).

In a storage operation, digital transaction data from a transaction device (14) is stored in a database (30) of a system controller (18). A video card (27) merges the stored digital transaction data with a corresponding camera (12) composite video signal to create a mixed composite video signal. The mixed composite video signal is stored on a videotape (19) at a video storage system (20) which is coupled to the system controller (18).

In an audit operation, an audit controller (21) loads the digital transaction data stored by the system controller (18). The audit controller (21) is remote from a system controller (18) (col. 5, lines 5-7). Identified transaction data can be displayed on a monitor (34). A pointer can be used to identify the portion of the videotape (19) which contains the desired transaction data in the stored mixed composite video signal. A VCR (22) can then be operated to review the video portion of the videotape (19) on-site at the initial video storage system (20) (col. 7, lines 5-10). Alternatively, the videotape (19) can be removed from the initial VCR (22) and mailed to a different VCR associated with the audit controller for review thereof.

(iii)   35 U.S.C. § 102

The Pending Claims Are Not Anticipated By Blackwell

In the Action claims 1-37 were rejected under 35 U.S.C. § 102(b) as being anticipated by Blackwell. The Appellants respectfully disagree with the Action's interpretation and application of Blackwell.

The Acton alleges that Blackwell has a camera (52, 54, 56) adjacent an automated banking machine. Thus, as the Action is best understood, the remote terminal (20, 22, 24) of Figure 2 (which is associated with the cameras 52, 54, 56) is alleged as the recited automated banking machine.

Blackwell does not teach each and every feature and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections.

Blackwell does not explicitly or inherently teach the recited method. Nor are the Action's assertions based on any evidence in the record. The evidence of record must teach the recited features and relationships. An assertion of knowledge not based on any evidence in the record lacks substantial evidence support. Rather, the Office must point to some concrete evidence in the record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Blackwell does not anticipate claims 1-37.

Claim 1

Blackwell does not teach the recited features and relationships. For example, Blackwell does not teach a computer in operative connection with an <u>automated</u> banking machine (which is operative to carry out at least one transaction function) and a camera (adjacent the machine), wherein the computer is operative to include image data corresponding to camera signals in a data store <u>responsive</u> to <u>the machine</u> carrying out at least one transaction function. Blackwell does not teach that a computer is operative to include image data in a data store <u>responsive</u> to an automated banking <u>machine</u> carrying out at least one transaction function. Where does

Blackwell teach storing image data in response to the operation of a transaction function device of an automated banking machine?

In Blackwell an image is captured and stored in response to the banker, e.g., the banker clicking on a mouse (col. 13, lines 43-55; Figure 6B; col. 15, lines 27-34; col. 12, lines 8-11), not in response to an automated banking machine carrying out at least one transaction function. That is, in Blackwell an image is captured and stored in response to a person. Where does Blackwell teach including image data in a data store (in the manner recited) in response to a machine, especially an automated banking machine?

The Action relies on Blackwell at col. 5, lines 48-51 as allegedly teaching the recited features and relationships. However, Blackwell at the cited section merely indicates that "remote terminals are interconnected for communication with each other and with a network server (not shown) via a local area network." Thus, the relied upon section of Blackwell is not related to including image data in a data store responsive to an automated banking machine carrying out at least one transaction function. Nor does Blackwell teach the recited features and relationships.

Beginning on page 12 of the Action the Examiner provides additional comments in addressing some of Appellants' arguments regarding the Blackwell reference. The Appellants again respectfully disagree with the Action's interpretation and application of Blackwell.

On page 13 the Action alleges that Blackwell teaches that a "computer is operative to include image data corresponding to camera signals in data stored responsive to the machine carrying out at least one transaction function." The Action (on page 13) further alleges that

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Blackwell "teaches storing image data (document stored in image file) in response to the operation of a transaction function device of an automated banking machine."

As previously discussed, because the Acton alleges that Blackwell has a camera (52, 54, 56) adjacent an automated banking machine, it follows that the Action (as best understood) alleges that the remote terminal (20, 22, 24) of Figure 2 constitutes the recited automated banking machine. However, Blackwell's camera signals are not stored in a data store responsive to the alleged automated banking machine of Figure 2. Nor is there is any teaching in Blackwell that a computer stores image data in a data store. Rather, as previously discussed, an image is captured in a data file in response to the banker (person) clicking their mouse (col. 13, lines 43-55) at a location distant from the alleged automated banking machine of Figure 2. That is, in Blackwell not only is the image data storage responsive to an action away from the alleged automated banking machine of Figure 2, but the action is not even responsive to a machine. The alleged automated banking machine of Figure 2 has no bearing whatsoever on when an image is stored in a data store. That is, without the banker's mouse action, the alleged automated banking machine of Figure 2 could operate indefinitely without an image ever being stored. It follows that in Blackwell, image data is not included in a data store responsive to an automated banking machine, nor responsive to an automated banking machine carrying out a transaction function. Again, in Blackwell the image storage is based on the mouse action of the banker (who is located at a verification terminal which is distant from the alleged automated banking machine).

The Action also alleges that "the verification transaction is a transaction function." However, if the image storage in Blackwell is a part of the verification transaction, then how can

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the image storage be in _response_ to the verification transaction? Furthermore, the banker signs verification after image storage (col. 13, lines 51-66). Nevertheless, the verification transaction depends on the banker, not on an automated banking machine. Again, image data is not included in a data store _responsive to_ an automated banking machine carrying out a transaction function.

The Action at page 14 alleges that all that is claimed is "an automated banking machine carrying out at least one transaction" and "a user terminal including an output device in operative connection with the network." The Appellants respectfully disagree. Clearly, claim 1 recites at least: an automated banking machine; at least one camera; a computer; at least one communication network; a user terminal; and the relationships thereof. The Action's allegation of claim 1 having only two recited features is a further example of the Office's unfair claim interpretation, and is reflective of all the rejections on appeal.

The Action at page 14 further refers to "automating a manual process" and _In re Venner_. Apparently the Office is acknowledging that Blackwell's image storage is responsive to the banker person manually clicking their mouse, and not an automated machine. Furthermore, _In re Venner_ is directed to an obviousness type of rejection. Is the Office admitting that Blackwell does not anticipate claim 1? Blackwell requires the use of a banker person to perform at least one manual process (e.g., manually verifying a customer's credentials). Blackwell teaches away from automating the required manual process. Blackwell also specifically teaches that "Of primary importance to the present invention" is "verification of the identity of the user of the remote terminal by the verification authority, the banker" (col. 12, lines 8-11). Blackwell's explicit teaching of requiring a banker person differs from claim 1. Blackwell's image storage is

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responsive to a required manual process, not responsive to an automated process, and not responsive to an automated banking machine carrying out a transaction function. Blackwell cannot anticipate claim 1.

The Action at page 15 alleges that "Applicant argued that Blackwell relies on a person, not in response to a machine carrying out at least one transaction. In fact, Applicant's invention also require a user to operate at the transaction terminal (see claim 1). In addition, Applicant did not claim the apparatus is being operated without a person." The Appellants respectfully disagree. Again the Action (as best understood) misinterprets the claim. Where does claim 1 positively recite a "user" or a "transaction terminal"? Nevertheless, claim 1 does recite that a computer (in operative connection with an automated banking machine and a camera) "is operative to include image data corresponding to the camera signals in the data store responsive to the machine carrying out at least one transaction function." Thus, Appellants maintain that in Blackwell the storage of image data is responsive to a person's function instead of an automated banking machine's function. Additionally, Blackwell's image storage is responsive to an action performed (by a person at a verification terminal) distant from the alleged machine.

Appellants respectfully submit that Blackwell does not disclose each and every element and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. The rejection of claim 1 is based on the Office's alleged teachings of Blackwell, not factual showings of what Blackwell actually teaches. That is, the record lacks substantial evidence support. *In re Zurko*, supra. Therefore, Blackwell cannot

anticipate claim 1. Thus, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

Claim 2

Blackwell does not teach that a computer is operative to include image data in a data store responsive to an automated banking machine operating to provide cash. As previously discussed with regard to claim 1, Blackwell does not teach including image data in a data store (in the manner recited) in response to a machine, especially an automated banking machine. In Blackwell an image is captured and stored in response to a person clicking on a mouse (e.g., col. 13, lines 43-55), not in response to an automated banking machine carrying out at least one transaction function. Additionally, in Blackwell a user's identity document image is captured for verification in regard to opening an account or a loan (col. 14, lines 17-32), not in regard to a machine operating to provide cash. It follows that Blackwell cannot teach including image data in a data store responsive to an automated banking machine operating to provide cash.

The Action relies on Blackwell at col. 1, lines 37-65 and col. 8, lines 30-50 as allegedly teaching the recited features and relationships of claim 2. However, Blackwell at the cited col. 8, lines 30-50 relates to initializing a remote terminal, which is not related to the recited features and relationships of claim 2. Blackwell at the cited col. 1, lines 37-65 actually teaches that an ATM does not need to use image data to provide cash (col. 1, lines 42-53). Therefore, where does Blackwell associate image data storage with an ATM, especially an ATM operating to provide cash? Where does Blackwell associate image data storage with cash dispensing? It follows that Blackwell does not teach the recited feature of including image data in a data store

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responsive to an automated banking machine operating to provide cash. Thus, Blackwell cannot anticipate claim 2.

Claim 3

Claim 3 depends from claim 2. Blackwell does not teach that a computer is operative to include image data in a data store when an amount of cash provided by the machine is at least a predetermined amount. The Action relies on Blackwell at col. 1, lines 20-55 as allegedly teaching the recited features and relationships of claim 3. However, Blackwell at the cited section is not related to including image data in a data store with regard to an amount of cash provided by the machine, especially when the amount of cash provided is at least a predetermined amount. Nor does Blackwell teach the recited features and relationships of claim 3. Nor can Blackwell anticipate claim 3.

Claim 4

Blackwell does not teach an automated banking machine including a plurality of transaction function devices, and that a computer is operative to include image data in a data store responsive to operation of each of a plurality of transaction function devices during a transaction. Where does Blackwell teach including image data in a data store responsive to operation of even one transaction function device? As previously discussed with regard to claim 1, Blackwell relies on a person, not in response to a machine carrying out at least one transaction function. It follows that Blackwell cannot teach including image data in a data store responsive to operation of each of a plurality of transaction function devices during a transaction. Thus, Blackwell cannot anticipate claim 4.

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The Action relies on Blackwell at col. 10, lines 55-67 as allegedly teaching the recited features and relationships of claim 4. However, Blackwell at the cited section relates to commands initiated by a person (banker). Thus, the relied upon section of Blackwell is not related to including image data in a data store responsive to operation of each of a plurality of transaction function devices in an automated banking machine during a transaction. Again, Blackwell cannot anticipate claim 4.

Claim 5

Blackwell does not teach (at least) that a computer is operative to sense lack of usable video from a first camera. The Action relies on Blackwell at col. 6, lines 50-65 as allegedly teaching the recited features and relationships of claim 5. However, Blackwell at the cited section relates to a camera (54) for capturing a person at remote terminal, and a camera (56) for providing an image of the remote terminal. Thus, the relied upon section of Blackwell does not teach or suggest sensing lack of usable video from a camera. Blackwell teaches nothing about an instruction sequence as specifically recited. Where does Blackwell teach that a computer is operative to sense lack of usable video from one camera to cause images to be captured from another camera responsive to a sequence? Blackwell does not anticipate claim 5.

Claim 6

Blackwell does not teach that a banking machine carries out a transaction function responsive to input data, nor that a computer is operative to include in a data store transaction data corresponding to the input data. The Action relies on the abstract of Blackwell as allegedly

teaching the recited features and relationships of claim 6. However, the abstract is not related to input data in the manner recited. It follows that Blackwell does not anticipate claim 6.

Claim 7

Claim 7 depends from claim 6. Blackwell further does not teach a user terminal that is operative to process transaction data and to output indicia in the manner recited. Nor does Blackwell anticipate claim 7.

Claim 8

Blackwell does not teach a computer that is operative to include in a data store, image data corresponding to camera signals of a service area of an automated banking machine. Blackwell has a camera (56) for providing an image of a remote booth-like terminal (Figure 2). However, there is no teaching in Blackwell that image data corresponding to the camera (56) is stored in a data store. Blackwell is limited to storing an image of an identity document (col. 13, line 43 to col. 14, line 16) associated with the document camera (52).

Nevertheless, Blackwell also does not teach producing camera signals corresponding to a service area of an automated banking machine. Where does Blackwell teach servicing an automated banking machine? Where does Blackwell teach producing images of an area of a machine in which activities to service the machine are conducted?

Claim 9

Claim 9 depends from claim 8. Blackwell does not teach having a (second) camera located in an interior of an automated banking machine. Where does Blackwell teach having a camera in a machine?

Claim 10

Claim 10 depends from claim 8. Blackwell does not teach that a data store includes motion detection instructions, and a computer is operative responsive to the motion detection instructions to include image data corresponding to second camera signals in the data store.

Claim 11

Claim 11 depends from claim 8. Blackwell does not teach a computer operative, responsive to data store instructions and a sensor indicating that a service area door has been moved to an open condition, to include image data corresponding to second camera signals in the data store. Where does Blackwell teach a door operative to provide access to a service area? Furthermore, where does Blackwell teach a sensor in operative connection with the door?

Claim 12

Claim 12 depends from claim 11. Blackwell also does not teach that the computer is further operative responsive to the instructions to send an e-mail message through a network.

Claim 13

Blackwell does not teach a data store including instructions representative of a sequence, and a computer, responsive to the instructions, is operative to include image data in the data store. Nor does Blackwell anticipate claim 13.

Claim 14

Blackwell does not teach determining a time period during which a data store is expected to continue to accept additional data. The Action relies on Blackwell at col. 10, lines 5-15 as

allegedly teaching the recited features and relationships of claim 14. However, Blackwell at the cited section relates to preparing remote terminal identifier data and the telephone number of the remote terminal for later use in the event that connection between the customer and banker is broken and needs to be reestablished. The relied upon section of Blackwell is not related to a time period, especially a time period during which a data store is expected to continue to accept additional data. Thus, Blackwell does not anticipate claim 14.

Claim 15

Claim 15 depends from claim 14. Blackwell does not teach that a computer, responsive to message instructions, is operative to send a message (which includes data representative of a time period) through a network.

Claim 16

Claim 16 depends from claim 14. Blackwell does not teach a computer that calculates a time period responsive to a transaction history pattern.

Claim 17

Blackwell does not teach a server and data store located within a banking machine. As previously discussed, the Action (as best understood) alleges that Blackwell's remote terminal (20, 22, 24) constitutes an automated banking machine. However, in Blackwell the merged file is sent away from the remote terminal for permanent storage (col. 14, lines 12-16). Thus, it is unclear where Blackwell teaches that the data store is located within a banking machine. The cited section (col. 5, lines 48-51) of Blackwell merely indicates that the remote terminals are

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interconnected with a network server. There is no evidence that Blackwell has a server within each remote terminal, nor that a server is even required at each remote terminal. Furthermore, Blackwell's usage of a common network server for the remote terminals teaches away from each remote terminal having their own server. The record lacks substantial evidence support. *In re Zurko*, supra. It follows that Blackwell does not anticipate claim 17.

Claim 18

Blackwell does not teach that camera signals are transmitted to a computer through a network in the manner recited.

Claim 19

Blackwell does not teach a camera server in operative connection with a camera. Where does Blackwell teach a camera server? The cited section (col. 5, lines 48-51) merely refers to the use of a network server in association with the remote terminals.

Claim 20

Blackwell does not teach a further network in operative connection with a plurality of cameras and the computer in the manner recited.

Claim 21

Claim 21 depends from claim 20. Nor does Blackwell teach that a further network (in operative connection with a plurality of cameras) includes a power supply network.

Claim 22

Blackwell does not teach the recited data store. Where does the relied upon section (col. 15, lines 5-65) of Blackwell teach that image data is recorded on a removable storage medium?

Claim 23

Blackwell does not teach determining if an amount of image data in a data store is at a level, and a computer being operative to transfer data through a network to a remote data store, responsive to the amount being as great as the level. The Action relies on Blackwell at col. 5, line 25 to col. 10, line 15 as allegedly teaching the recited features and relationships of claim 23. However, the Action is silent as to where the lengthy cited section of Blackwell actually teaches the recited features and relationships relating to an amount of image data in a data store being at a level, a computer being operative to transfer data through a network, and a remote data store. Nor does Blackwell teach the recited features and relationships. Nor does Blackwell anticipate claim 23.

Claim 24

Claim 24 depends from claim 23. Nor does Blackwell teach further instructions to erase image data in the data store after transfer of image data to the remote data store. The Action (at page 7) alleges that it is "inherent to" remotely perform data editing. It is unclear whether the Action alleges inherency in the Blackwell reference or some other reference, because Blackwell does not inherently teach the recited features as alleged.

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities (e.g., "inherent to"). It is plainly improper to reject a claim on the

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basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

The Appellants respectfully submit that the Office has not proved that the feature alleged to be inherent is "necessarily present" in the Blackwell reference. Furthermore, the record lacks substantial evidence support. *In re Zurko*, supra.

Claim 25

Blackwell does not teach an imaging device that is operative to generate document image signals corresponding to at least one appearance feature of documents input to the machine. Where does the relied upon lengthy section of Blackwell teach the input of documents to an automated banking machine?

Claim 26

Claim 26 depends from claim 25. Nor does Blackwell teach that document image data is stored in correlated relation with image data produced responsive to camera signals. Where does Blackwell teach image data produced responsive to camera signals? Where does Blackwell teach that document image data is stored in correlated relation with image data? Blackwell is limited to storing an image of an identity document (col. 13, line 43 to col. 14, line 16). Where does Blackwell teach or need to store other image data?

Claim 27

Claim 27 depends from claim 25. Nor does Blackwell teach that a server is operative responsive to data store instructions to deliver document image data through a network.

Claim 28

Claim 28 depends from claim 27. Nor does Blackwell teach that a document verification terminal is operative to access document image data through a server and to compare the document image data and indicia (which is indicative of the genuineness of documents) from a verification data store.

Claim 29

Claim 29 depends from claim 28. Nor does Blackwell teach that a document verification terminal is operative to compare signatures in documents represented by document image data, to data representative of written signatures in the verification data store. Where does Blackwell teach the ability to compare signatures?

Claim 30

Claim 30 depends from claim 4. Blackwell does not teach that a user terminal display is operative to display a plurality of images corresponding to operation of transaction function devices during a transaction, together in a set on the display. Where does Blackwell teach displaying images corresponding to operation of transaction function devices during a transaction?

Claim 31

Claim 31 depends from claim 30. Nor does Blackwell teach the ability to select one of the images in a set and display a larger version of the selected image on a display.

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Claim 32

Claim 32 depends from claim 31. Nor does Blackwell teach a computer that is operative to store data representative of transaction data in a data store in correlated relation with corresponding image data.

Claim 33

Claim 33 depends from claim 31. Nor does Blackwell teach that selection of an icon with an input device is operative to selectively cause images in a series of images to be made visible on a display.

Claim 34

Claim 34 depends from claim 33. Nor does Blackwell teach that selection of a first icon is operative to cause an image in a first direction in the series to be made visible, and selection of a second icon is operative to cause an image in a second direction in the series to be made visible on the display.

Claim 35

Claim 35 depends from claim 33. Nor does Blackwell teach that selection of an icon is operative to scroll through a series of images.

Claim 36

Claim 36 depends from claim 33. Nor does Blackwell teach that selection of a first icon is operative to cause display of an image in a series disposed of a first number of images from a currently displayed image, and selection of a second icon is operative to cause display of an image in a series disposed of a second number of images from a currently displayed image.

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Claim 37

Claim 37 depends from claim 36. Nor does Blackwell teach that an image displayed responsive to the first icon, and an image displayed responsive to selection of the second icon, are each disposed in a first direction from the currently displayed image. It follows that Blackwell does not anticipate claim 37.

(iv)   35 U.S.C. § 103

The Appellants respectfully submit that the attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged. Furthermore, without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the cited art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

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Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of the references to have produced the recited invention.

The Office does not factually support any *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

The Pending Claims Are Not Obvious Over
Blackwell in view of Odle

Claims 38-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Blackwell in view of Odle. These rejections are respectfully traversed.

The Action (page 11) admits that Blackwell does not teach or suggest a computer being operative to store and/or retrieve image on a "date field". The Action relies on Odle as allegedly teaching this feature.

Appellants respectfully submit that claims 38-43 do not recite a "date field". Nevertheless, neither Blackwell nor Odle, taken alone or in combination, disclose or suggest the recited features and relationships.

Claim 38

Appellants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein.

The Action admits that Blackwell does not teach or suggest the ability to store and retrieve the image data in the manner recited. Blackwell does not teach or suggest that a computer is operative to store image data corresponding to camera signals in a data store responsive to operation of a selected function device of an ATM. Nor does Blackwell teach or suggest that the computer is operative to store the image data on a first date and a remote terminal is operative to receive retrieved stored image data on a second date. Nor does Blackwell teach or suggest that the remote terminal is operative to display images corresponding to the retrieved image data. Also, where does Blackwell teach storing image data corresponding to camera signals (corresponding to at least one human image) in a data store? Blackwell is limited to storing an image of an identity document (col. 13, line 43 to col. 14, line 16) and has no need to store other image data.

Odle cannot overcome the admitted and previously discussed deficiencies of Blackwell as it does not disclose or suggest the recited features which are not found in Blackwell. Odle, like Blackwell, also does not teach or suggest that a computer is operative to store image data corresponding to camera signals in a data store responsive to operation of a selected function device of an ATM. Rather, Odle desires to capture and store all relevant information (col. 2, lines 35-39). Thus, the record lacks substantial evidence support. *In re Zurko*, supra.

Nor does Odle teach or suggest a remote terminal in operative connection with a network and an image data store, and operative to receive retrieved stored image data. Odle desires that the video signal be stored on a VCR tape. Odle's audit controller is not in operative connection with the VCR tape (the alleged data store). Nor is there any teaching or suggestion that Odle's

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video storage article (i.e., VCR tape) is in a format and an arrangement permitting operative connection with the audit controller. Rather, Odle requires that the VCR tape be sent by mail in order to be reviewed at the audit controller (col. 7, lines 5-10). It follows that Odle does not teach or suggest a remote terminal in operative connection with an image data store. Thus, it would not have been obvious to one having ordinary skill in the art to have modified Blackwell with the teachings of Odle to have produced the recited invention.

The Action is devoid of any such teaching, suggestion, or motivation for combining the references. Blackwell stores a digitized (single) image of a document. Odle stores video on a VCR tape. Odle uses a pointer to distinguish the portion of the VCR tape that corresponds to a particular transaction from the tremendous amount of video stored. Odle is non analogous art. Nor does Blackwell have any need of the teachings of Odle. Thus, it is unclear how Blackwell could be modified by the teachings of Odle to have produced the recited invention.

Furthermore, any attempt to modify Blackwell with the teaching of Odle would destroy the disclosed and desired utility and operability of the Blackwell teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Additionally, even if it were somehow possible to combine the references (which it isn't) the resultant combination would not have been obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01). Nevertheless, even if it were somehow possible to combine the references (which it isn't) the resultant combination still would not have

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produced the recited invention. Neither Blackwell nor Odle, taken alone or in combination, disclose or suggest the recited features and relationships. The Office has not established a *prima facie* showing of obviousness.

Claim 39

Claim 39 depends from claim 38. Neither of the applied references, taken alone or in combination, disclose or suggest a computer that is operative to store image data in a data store responsive to operation of a selected transaction function device during an ATM transaction. Nor has the Office established a *prima facie* showing of obviousness.

Claim 40

Claim 40 depends from claim 39. Neither of the applied references, taken alone or in combination, disclose or suggest a terminal that is operative to display images corresponding to customer image data in the manner recited. Nor would it have been obvious to have modified Blackwell with the teachings of Odle to have produced the claimed invention.

Claim 41

Appellants' remarks in support of the patentability of claims 1 and 38 are incorporated by reference as if fully rewritten herein.

Blackwell does not teach or suggest that a computer is operative to include image data in a data store responsive to an ATM carrying out a transaction function through operation of a transaction function device. Nor does Blackwell teach or suggest that the computer is operative to include the image data in the data store at a first time and a remote terminal is operative to output images corresponding to the image data at a second time. The Action admits that

Blackwell does not teach or suggest the ability to store and retrieve the image data in the manner recited.

Odle cannot overcome the admitted and previously discussed deficiencies of Blackwell as it does not disclose or suggest the recited features which are not found in Blackwell. Odle, like Blackwell, also does not teach or suggest that a computer is operative to include image data in a data store responsive to an ATM carrying out a transaction function through operation of a transaction function device. Rather, as previously discussed, Odle desires to capture and store all relevant information (col. 2, lines 35-39). Thus, the record lacks substantial evidence support. *In re Zurko*, supra.

Odle also does not teach or suggest that a remote terminal is operative to communicate with a server (in operative connection with an image data store) and to output images corresponding to the image data. As previously discussed, Odle is non analogous art.

It would not have been obvious to one having ordinary skill in the art to have modified Blackwell with the teachings of Odle to have produced the recited invention. The Action is devoid of any such teaching, suggestion, or motivation for combining the references. The Action's attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. Furthermore, as previously discussed, any attempt to modify Blackwell with the teaching of Odle would destroy the disclosed and desired utility and operability of the Blackwell teaching. Even if it were somehow possible to combine the references (which it isn't) the resultant combination would not

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have been obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01). Additionally, even if it were somehow possible to combine the references (which it isn't) the resultant combination still would not have produced the recited invention. Neither Blackwell nor Odle, taken alone or in combination, disclose or suggest the recited features and relationships. The Office has not established a *prima facie* showing of obviousness.

Claim 42

Claim 42 depends from claim 41. Neither of the applied references, taken alone or in combination, disclose or suggest that a computer is operative to include image data in a data store responsive to an ATM carrying out a transaction function through operation of a transaction function device, especially where the image device is located in an interior of the ATM. Nor has the Office established a *prima facie* showing of obviousness.

Claim 43

Claim 43 depends from claim 42. Neither of the applied references, taken alone or in combination, disclose or suggest that a computer is operative to include image data in a data store responsive to an ATM carrying out a transaction function through operation of a transaction function device, especially where a server and the data store are located in the interior of the ATM. Nor has the Office established a *prima facie* showing of obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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APPENDIX

CLAIMS

1. Apparatus comprising:

    an automated banking machine carrying out at least one transaction function;

    at least one camera adjacent the banking machine, wherein the camera is operative to produce camera signals corresponding to images;

    a computer including a server in operative connection with a data store, wherein the computer is in operative connection with the machine and the camera, and wherein the computer is operative to include image data corresponding to the camera signals in the data store responsive to the machine carrying out at least one transaction function;

    at least one communication network in operative connection with the server; and

    a user terminal including an output device in operative connection with the network, wherein the user terminal includes a browser, and wherein the user terminal communicates with the server through the browser and is operative to output images corresponding to the image data through the output device.

2.   The apparatus according to claim 1 wherein the banking machine is operative to provide cash, and wherein the computer is operative to include image data in the data store responsive to the machine operating to provide cash.

3.   The apparatus according to claim 2 wherein the data store includes instructions including data representative of a predetermined amount, and wherein the computer is operative to include image data in the data store when an amount of cash provided by the machine is at least the predetermined amount.

4.   The apparatus according to claim 1 wherein the machine includes a plurality of transaction function devices, and wherein the computer is operative to include image data in the data store responsive to operation of each of a plurality of transaction function devices during a transaction.

5.   The apparatus according to claim 1 and further comprising a plurality of cameras, and wherein the data store further comprises instructions including a sequence, wherein the computer is operative to sense lack of usable video from a first camera and to store image data from a second camera responsive to the sequence.

6. The apparatus according to claim 1 wherein the banking machine includes an input device, and wherein the input device receives input data through the input device, and wherein the banking machine carries out the transaction function responsive to the input data, and wherein the computer is operative to include in the data store transaction data corresponding to the input data.

7. The apparatus according to claim 6 wherein the user terminal is operative to process the transaction data with the browser, and to output indicia corresponding to the transaction data with the output images through the output device.

8. The apparatus according to claim 1 and further comprising a second camera, wherein the second camera produces second camera signals corresponding to a service area of the machine, and wherein the computer is operative to include in the data store image data corresponding to the second camera signals.

9. The apparatus according to claim 8 wherein the second camera is located in an interior of the automated banking machine.

10. The apparatus according to claim 8 wherein the data store further includes motion detection instructions, and wherein the computer is operative responsive to the motion detection

instructions to include the image data corresponding to the second camera signals in the data store.

11. The apparatus according to claim 8 and further comprising a door, wherein opening the door is operative to provide access to the service area, and further comprising a sensor in operative connection with the door, and further comprising instructions in the data store, wherein the computer is operative responsive to the instructions and the sensor indicating that the door has been moved to an open condition, to include the image data corresponding to the second camera signals in the data store.

12. The apparatus according to claim 11 wherein the computer is further operative responsive to the instructions to send an e-mail message through the network.

13. The apparatus according to claim 1 wherein the data store includes instructions representative of a sequence, and wherein the computer is operative responsive to the sequence to include image data in the data store, and wherein the user terminal has in connection therewith a user terminal input device, and wherein the sequence is changeable through an input to the user terminal input device.

14. The apparatus according to claim 1 wherein the data store includes instructions for determining a time period during which the data store is expected to continue to accept additional

data, and wherein the computer is operative responsive to the instructions to calculate such a time period.

15.   The apparatus according to claim 14 wherein the instructions include message instructions for sending a message, and wherein the computer is operative responsive to the message instructions to send a message through the network wherein the message includes data representative of the time period.

16.   The apparatus according to claim 14 wherein the data store includes a transaction history pattern, and wherein the computer calculates the time period responsive to the transaction history pattern.

17.   The apparatus according to claim 1 wherein the server and data store are located within the banking machine.

18.   The apparatus according to claim 1 wherein the camera signals are transmitted to the computer through a network.

19.   The apparatus according to claim 1 and further comprising a camera server in operative connection with the camera, wherein the camera server is in operative connection with the computer.

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20. The apparatus according to claim 1 and further comprising a plurality of cameras, and wherein a further network is in operative connection with the plurality of cameras and the computer, wherein the plurality of cameras communicate with the computer through the further network.

21. The apparatus according to claim 20 wherein the further network includes a power supply network.

22. The apparatus according to claim 1 wherein the data store comprises a recording device having a removable storage medium, wherein the image data is recorded on the removable storage medium.

23. The apparatus according to claim 1 wherein the data store includes instructions for determining if an amount of image data in the data store is at a level, and further comprising a remote data store in operative connection with the network, wherein the computer is operative responsive to the amount of the image data being as great as the level, to transfer data through the network to the remote data store.

24. The apparatus according to claim 23 wherein the data store includes further instructions, wherein the computer is operative responsive to the further instructions to erase image data in the data store after transfer of such image data to the remote data store.

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25. The apparatus according to claim 1 wherein the banking machine includes an imaging device, wherein the imaging device is operative to generate document image signals corresponding to at least one appearance feature of documents input to the machine, and wherein the data store includes instructions, and the computer is further operative responsive to the instructions to include in the data store document image data corresponding to the document image signals.

26. The apparatus according to claim 25 wherein the document image data is stored in correlated relation with image data produced responsive to the camera signals.

27. The apparatus according to claim 25 wherein the data store includes further instructions, and the server is operative responsive to the further instructions to deliver the document image data through a network.

28. The apparatus according to claim 27 and further comprising a document verification terminal in operative connection with the network, and wherein the document verification terminal is in operative connection with a verification data store including data representative of indicia which is indicative of the genuineness of documents, and wherein the document verification terminal includes a further browser, and wherein the document verification terminal is operative to access the document image data through the server and to compare the document image data and the indicia from the verification data store.

29. The apparatus according to claim 28 wherein the indicia in the verification data store corresponds to written signatures, and wherein the document verification terminal is operative to compare signatures in documents represented by the document image data, to data representative of the written signatures in the verification data store.

30. The apparatus according to claim 4 wherein the output device of the user terminal comprises a display, and wherein the display is operative to display a plurality of images corresponding to operation of the transaction function devices during the transaction, together in a set on the display.

31. The apparatus according to claim 30 wherein the user terminal further comprises an input device, wherein the input device is selectively operative to select one of the images in a set, and wherein the user terminal is operative responsive to selection of one image in a set, to display a larger version of the selected image on the display.

32. The apparatus according to claim 31 wherein the banking machine is operative to produce transaction data responsive to operation of at least one transaction function device, and wherein the computer is operative to store data representative of the transaction data in a data store in correlated relation with the corresponding image data, and wherein the transaction data is accessed by the user terminal with the browser, and wherein the corresponding transaction data is output on the display of the user terminal with the selected image.

33.   The apparatus according to claim 31 wherein the display includes an icon, and wherein selection of the first icon with the input device is operative to selectively cause images in a series of images to be made visible on the display.

34.   The apparatus according to claim 33 and wherein the display comprises a first icon and a second icon, wherein selection of the first icon with the input device is operative to cause at least one image in a first direction in the series to be made visible and wherein selection of the second icon with the input device is operative to cause at least one image in a second direction in the series other than the first direction, to be made visible on the display.

35.   The apparatus according to claim 33 wherein selection of the icon is operative to scroll through the series of images.

36.   The apparatus according to claim 33 wherein the display comprises a first icon and a second icon, wherein selection of the first icon with the input device is operative to cause at least one image in the series disposed of a first number of images in the series from a currently displayed image, to be displayed on the display, and wherein selection of the second icon with the input device is operative to cause at least one image in the series disposed a second number of images in the series from a currently displayed image, to be displayed.

37. The apparatus according to claim 36 wherein the at least one image displayed responsive to the first icon and the at least one image displayed responsive to selection of the second icon, are each disposed in a first direction in the series from the currently displayed image.

38. Apparatus comprising:

an automated teller machine (ATM), wherein the ATM includes a plurality of function devices;

at least one camera adjacent the ATM, wherein the camera is operative to produce camera signals corresponding to at least one human image;

a computer in operative connection with a data store and the at least one camera, wherein the computer is operative to store image data corresponding to the camera signals in the data store responsive to operation of a selected function device, wherein the computer is operative to store the image data on a first date;

at least one communication network in operative connection with the data store;

a terminal in operative connection with the network and the data store, wherein the terminal is remotely located from the ATM, wherein the terminal includes a display device, wherein the terminal is operative to receive retrieved stored image data on a second date different from the first date, and wherein the terminal is operative to display images corresponding to the retrieved image data through the display device.

39.   The apparatus according to claim 38 wherein the function devices comprise transaction function devices, wherein the computer is operative to store image data corresponding to the camera signals in the data store responsive to operation of a selected transaction function device during an ATM transaction.

40.   The apparatus according to claim 39 wherein the camera is operative to produce camera signals corresponding to a customer of the ATM, and wherein the terminal is operative to display images corresponding to customer image data through the display device.

41.   Apparatus comprising:

an automated teller machine (ATM) including a plurality of transaction function devices;

at least one image device adjacent the ATM, wherein the at least one image device is operative to produce signals corresponding to images;

a computer including a server in operative connection with a data store, wherein the computer is in operative connection with the ATM, and wherein responsive to the ATM carrying out at least one ATM transaction function through operation of at least one transaction function device, the computer is operative at a first time to cause image data corresponding to the signals to be included in the data store;

at least one network in operative connection with the server;

a user terminal remotely located from the ATM and in operative connection with the network, wherein the user terminal includes an output device, and wherein the user terminal is operative to communicate with the server and to output images corresponding to the image data through the output device at a second time subsequent to the first time.

42.   The apparatus according to claim 41 wherein the at least one image device is located in an interior of the ATM.

43.   The apparatus according to claim 42 wherein the server and the data store are located in the interior of the ATM.

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